



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897.163	06/28/2001	Stephen C. Davis	A179 1010.1	1461

7590 05/08/2003

Womble Carlyle Sandridge & Rice, PLLC
P.O. Box 7037
Atlanta, GA 30357-0037

EXAMINER

VO, HAI

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 05/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/897,163

Applicant(s)

DAVIS ET AL.

Examiner

Hai Vo

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 31-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 31-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

1. Non-elected claims 15-30, and 41-44 have been cancelled in the amendment received on 02/25/2003.

Claim objections

2. Claim 12 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 12 fails to further limit the subject matter of claim 1.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 31 and 35-39 are rejected under 35 U.S.C. 103(a) as being anticipated by Horowitz et al (US 4,107,228) substantially as set forth in Paper 6.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 6-14, 31-33, and 35-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanduja et al (US 6,414,048) in view of Kreiser et al (US 6,245,267) substantially as set forth in Paper 6.
7. Claims 4, 5, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanduja et al (US 6,414,048) in view of Kreiser et al (US 6,245,267) as applied to claims 1 and 31 above, in view of Mao et al (US 5,846,024). The combination of the primary and secondary references fails to teach the presence of the latex in the coating composition. Mao teaches a water-based coating used in the roofing industry comprising a neoprene latex to provide additional strength and flexibility (column 5, lines 48-51). (US 5853890 to Odawa teaches that a water-based coating used in the roofing industry are made of polyurethane). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the latex into a water based coating of Sanduja as modified by Kreiser motivated by the desire to increase strength and flexibility of the coating.

Response to arguments

8. The specification and claim objections have been overcome by the present amendment.
9. The art rejections over Sanduja in view of Kreiser and Stoddard have been overcome by the present response.
10. The 102 art rejections over Horowitz have been maintained for the following reasons. The arguments that Horowitz teaches a paint composition that is not

Art Unit: 1771

water-soluble are not found persuasive because they are not commensurate in scope with the claims. The claims do not exclude an embodiment where the coating is solvent-based paint composition that includes a water-dispersible prepolymer, a monomer, a catalyst and a graft initiator. Horowitz teaches a solvent-based paint composition including a water-dispersible urethane prepolymer, an epoxy prepolymer, a vinyl monomer, a catalyst and silver nitrate graft initiator (example 1, column 3, lines 59 and 63). Therefore, the art rejections over Horowitz are sustained.

11. The 103 art rejections over Sanduja in view of Kreiser have been maintained for the following reasons. The arguments that one of ordinary skill in the art would not motivated to combine Kreiser with Sanduja because Sanduja does not suggest a coating can be applied to a flexible foam to impart toughness are not found persuasive. In the first place, Sanduja teaches that a paint composition is coated onto a substrate such as a polyolefin tube (abstract). Kreiser teaches a tube made of a flexible, low density polyolefin foam to lower the thermal conductivity and offer a cost advantage (column 5, lines 60-65, and example 2). The examiner believes that cost effectiveness suggested by Kreiser is important to the expectation of successfully practicing the invention of Sanduja. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the paint composition of Sanduja onto the polyolefin tubing as taught in Kreiser motivated by the desire to obtain the cost advantage.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 5,853,890 discloses a water-based coating composition for surface treatment of metal sheets, household electric appliances, automobiles.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Tue-Fri, 8:30-6:00 and on alternating Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV
April 29, 2003


CHERYL A. JUSKA
PRIMARY EXAMINER